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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/878,908	06/19/1997	KARL-LUTZ LAUTERJUNG	09114/005001	8837

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EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/878,908

Applicant(s)

LAUTERJUNG, KARL-LUTZ

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32,65-73,75-79 and 81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32,65-73,75-79 and 81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/31/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 31, 2005 has been entered.

In addition, the supplemental amendment filed March 25, 2005 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 65 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the limitation "the undeformed diameter of said ring" on lines 6-7 has insufficient antecedent basis.

Claim Rejections Based Upon Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 65-69, 75-79, and 81 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Polansky (US 3,304,557) as evidenced by Hammerslag et al (US 4,921,482) or Penner et al (US 6,416,474) or Noland (US 4,201,035). Polansky discloses a tubular graft with free ends having a diameter with rings (12) as claimed. The picks (15,16) constitute a ring collectively and these filaments or picks can be formed from nylon; see the figures and column 2, line 41 to column 3, line 33. Hammerslag (see column 7, lines 59-64), Penner (see column 6, lines 1-10) and Noland (column 5, lines 31-50) each provide evidence that nylon (see column 2, line 58 of Polansky) is well known as a type of wire material and that wires are not exclusively made of metal. Each ring is seen as being made of windings or picks (15, 16) of wire as claimed some of which are located near the ends of the graft. The Examiner asserts that the picks of Polansky are windings of a strand of material.

Alternatively, one could argue that the picks of Polansky are not windings of a strand of material because there is no explicit description of such. However, even giving the claims this narrower interpretation does not render them patentable under Section 103 because the structure of multiple windings of a single wire and windings of a plurality is substantially identical in view of the fact that the picks of Polansky are all

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held tightly and integrally in the weave structure. For this reason, the Examiner asserts that the claimed invention, given a more narrow interpretation, would have been obvious over Polansky alone.

With regard to claim 68, since the minimum bending diameter is a function of the bending diameter of a solid ring as compared to a ring of multiple wires, the Examiner asserts that the ring of Polansky inherently has the claimed minimum bending diameter because it is a multiple wire ring as claimed.

Claims 70-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polansky (US 3,304,557) in view of Inoue (US 5,290,305). Polansky fails to disclose a bent structure of the device where the annular element is bent into a C shape as claimed. However, Inoue (see figures 12, 13, 17C and 18C) teaches that it was known to bend similar grafts into such a configuration. Even though Polansky and Inoue do not teach using the device as Applicant has claimed, the Examiner asserts that Polansky as modified need only be capable of being used as such. Since Inoue teaches that it was known to manipulate or configure similar grafts into a C shape, it is the Examiner's position that it would have been obvious to do the same with Polansky as a way to store or deliver the same. Since Inoue teaches that such a configuration can be made in the art, the Examiner asserts that Polansky is capable of being used as claimed since the means for doing such was known.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marcade (US 5,676,696) in view of Palmaz et al (US 5,316,023). Marcade meets all the limitations of the claim except for the use of a plurality of resilient elements or stents in

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the third and forth sections; see the front page, Figure 2, and column 13, line 44 to column 14, line 4. However, Palmaz teaches that it was known to use a plurality of stents instead of one where a long section of a graft needs support; see Figures 9, 10A, and 10B as well as column 10, line 1 to column 11, line 20. Therefore, it is the Examiner's position that it would have been obvious to use a plurality of stents instead of one as taught by Palmaz in the Marcade invention for the same reasons that Palmaz did the same and in order to use widely available less costly stents as apposed to one customized for each graft of Marcade.

Response to Arguments

Applicant's arguments with respect to the claim have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic
Primary Examiner
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